

REMARKS

Claims 1-21 are pending and under consideration. Reconsideration is respectfully requested.

Applicant requests entry of this Rule 116 Response and Request for Reconsideration. The MPEP §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The MPEP further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Claims 1-6, 8-13, and 15-20 are rejected under 35 U.S.C. §102(b) as being anticipated by Bailey et al. (U.S.P. 5,835,084). Claims 7, 14 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bailey in view of Kudoh et al. (U.S.P. 5,948,058). The rejections are traversed.

As set forth in MPEP §706.02 entitled Rejection on Prior Art, anticipation requires that the reference must teach every aspect of a claimed invention. Further, as set forth in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."

Independent claim 1 recites a device including "a managing module creating a list of each electronic mail having an "unread" state based on the unread/already-read information at a predetermined timing, and upon reading one of the electronic mails after the predetermined timing the state of "unread" being not changed; and a controller controlling a management of reading of the electronic mail with the state of "unread" on the list." (emphasis added) Independent claims 8 and 15 have similar recitations.

Applicant submits that Bailey does not support an anticipatory-type rejection by not describing features recited in each of the present application's independent claims and even *arguendo* combination of Bailey in view of Kudoh does not teach features recited by each of the present application's independent claims.

In item 3 of the Office Action, the Examiner asserts Bailey teaches:

upon reading one of the electronic mails after a predetermined timing [window pane hold a list of unread/already read message. Email messages are organized and mark as read or unread col. 3, lines 60-67; col. 4, lines 45-52 and col. 5, lines 10-32], the state of "unread" being not changed (a timer is set for a selected time-out period col. 5, lines 16-60 and col. 6, lines 21-38).

(Action at page 4, line 13 - page 5, line 7)

Applicants point out to the Examiner that the Examiner has incorrectly inserted a comma in

his quoting of claim 1 on page 5, line 1 so as to incorrectly read "upon reading one of the electronic mails after a predetermined timing, the state of "unread" being not changed." (comma underlined).

Rather claim 1 recites an action i.e., "upon reading one of the electronic mails after a predetermined timing" (phrase 1) that results in a specific result i.e., "the state of "unread" being not changed" (phrase 2) that necessarily follows from the action. Phrase 1 and Phrase 2 are not two non-connected actions, as the Examiner seems to assert.

Applicant respectfully submits that the Examiner has cited in the Office Action discussions within Bailey that show, instead, that Bailey does not teach "upon a reading of one of the electronic mails after the predetermined timing the state of "unread" being not changed."

Using the Examiner's citation to col. 5, lines 26-38, Bailey discusses:

At step 70, the processor executing the message application displays the highlighted message in the preview pane 54. The processor then sets a mark_as_read flag to FALSE (step 72) and sets a timer for a selected time-out period (step 74). Next, the computer monitors for activity evidencing user interest in the previewed message. An explicit action that causes the message to be marked as read occurs when the user explicitly opens the message (step 76). If the message is opened (i.e., the "yes" branch from step 76), the user is assumed to be reading the message and the mark_as_read flag is set to TRUE (step 78); otherwise, the flag remains FALSE.

For the convenience of the Examiner, a copy of FIG. 5 of Bailey is attached and annotated to illustrate the difference between the present invention and Bailey and highlight the Examiner's incorrect interpretation of both.

Highlight I: Fig. 5 of Bailey illustrates that in step 76 if a user has opened, i.e., read a message after a first time then the "YES" branch is followed to step 78 and the message is "Mark as read=True."

However, according to the present invention, *arguendo* using Bailey's FIG. 5, after step 76 a "state of 'unread' being not changed" (e.g., a "yes" branch) would not go to step 78. Instead, the "mark_as_read=false" indication from step 72 would remain unchanged.

Highlight II. Yet further, Bailey teaches away from the present invention, and from a possible modification, by showing in FIG. 5 that after a second predetermined time has elapsed in step 84 that a message is automatically marked as being read, even if the message was unread.

That is, Bailey, alone or in combination, teaches away from "after the predetermined timing the state of "unread" being not changed."

Summary

Since features recited by Independent claims 1, 8, and 15 (and respective dependent

claims 2-7, 9-14, and 16-21 are not taught by the cited and *prima facie* obviousness has not been established, the rejections should be withdrawn and claims 1-21 allowed.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Response should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: December 20, 2006

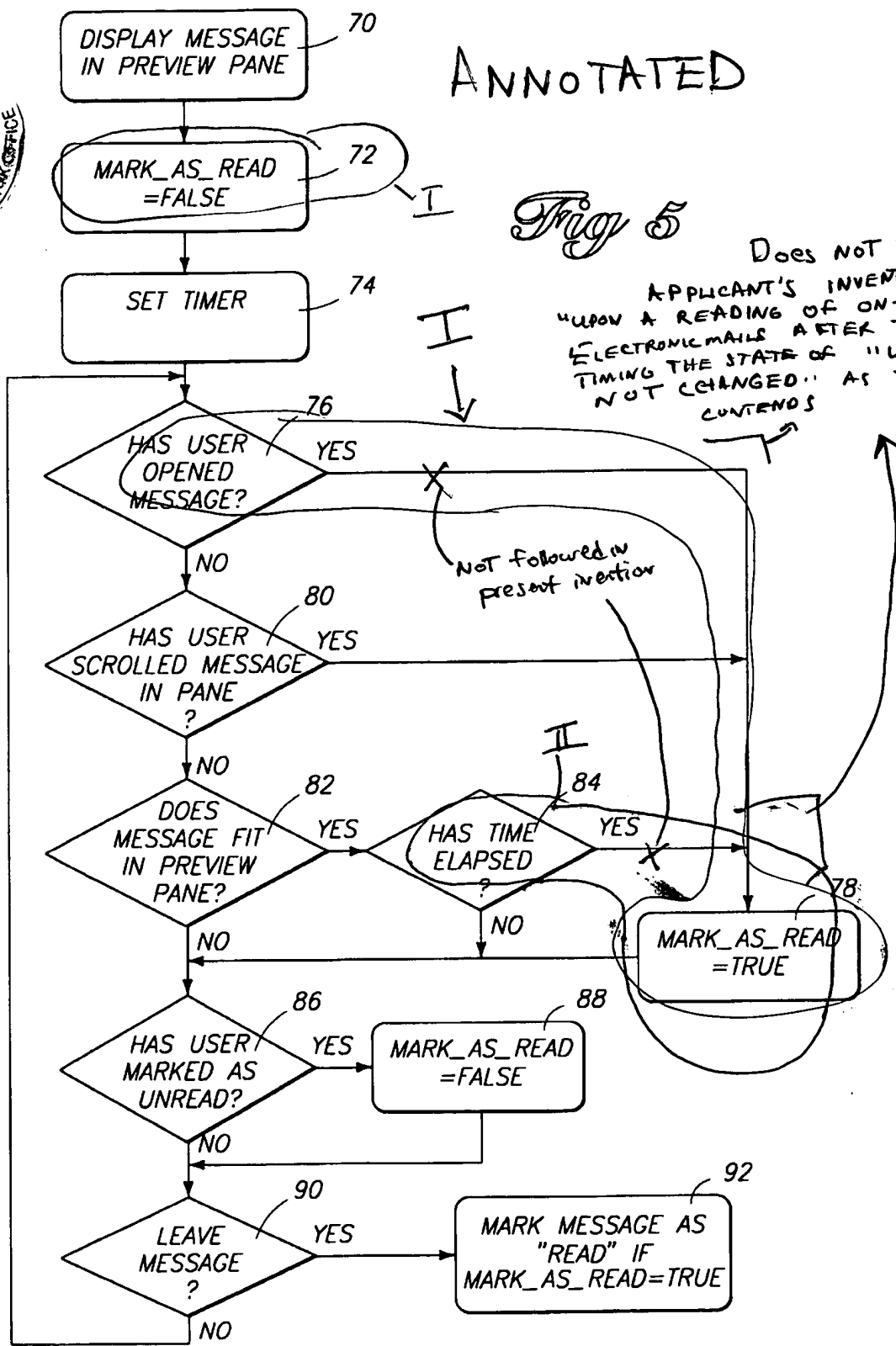
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ANNOTATED

Fig 5



ATTACHMENT